REMARKS

Formal Matters

Claims 1-33 were pending in the application and were restricted into eight groups. Claims 1-11, 15, 19-30 and 32 are canceled. As discussed below, Applicants elect with traverse claims 12-14, 16-18, 31, and 33 (Group IV). Claims 12-14, 16, 31 and 33 are amended and claims 34-38 are added. No new matter is added by the amendments to the claims.

Support for the amendments is found throughout the specification such as at, for example, page 11, lines 23-25; page 11, line 27 to page 12, line 7; page 12, line 23 to page 13, line 2; page 13, lines 3-21; page 19, lines 22-23 (legend to Fig. 8) and Fig. 8; page 20, lines 17-22; page 20, line 15 to page 23, line 17; page 97, line 14 to page 98, line 7 and Fig. 4; and page 100, lines 5-10, Fig. 8, and Table 5 (page 100). No new matter is added by the amendments to the claims.

Sequence Rules

Applicants are required to comply with the sequence rules as set forth in 37 C.F.R. § 1.821-25 at the time of election of the restriction. Applicants believe that they have already complied with 37 C.F.R. § 1.821-25 by submitting a Letter and Request to Use Computer-Feadable Sequence Listing Under 37 CFR § 1.821(e) upon filing the instant application on March 7, 2000 (copy of Letter enclosed). Specifically, the Letter requested that the computer-readable Sequence Listing filed in parent application Serial No. 09/070,416 be used as the computer-readable Sequence Listing for the instant application. A paper copy of the Sequence Listing and a statement that it is identical to the computer-readable copy from Serial No. 09/070,416 under 37 CFR § 1.821(e) was submitted with the Letter.

Applicants herewith submit another copy of the Sequence Listing for the systemics of the Examiner and in the unlikely sign metabore that the

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Applicants submit a copy of the Letter and Request and 37 CFR § 1.821(e), another paper copy of the Sequence Listing, and state that the computer readable copy and paper copy are identical, that no new matter is added by the amendment. As a result, Applicants believe that they have complied with the Notice to Comply.

Correction of Inadvertent Omission from the Specification When Filed

Upon filing the instant specification as a continuation of parent application 09/070,416 and provisional application serial no. 60/050,661, Appendix I was inadvertently omitted. Appendix I is a 15-page table comparing sequence identities between various light chain sequences. Insertion of the table into the specification does not add new matter because the table was present in the provisional application 60/050,661 to which the present application ultimately claims priority. Insertion of the Appendix as Table 6.1-6.15 is respectfully requested.

In a related application, U.S. application serial no. 08/850,058, the position of Appendix I was objected to. Appendix I was after "What is claimed is:" on page 103 and before the Claims. Applicants renamed the table as Table 6.1-6.15 and repositioned it to immediately before "What is claimed is:". Applicants respectfully offer this positioning scheme for consideration in the instant application.

Applicants submit Table 6.1-6.15 on fifteen pages. The word "Appendix" and the original page number on each page of the original appendix are deleted and "Table 6.X" is inserted therefor, where "X" refers to subpart 1-15 of Table 6.

The word "Appendix" occurs only once in the originally filed specification at page 96, line 24. The word "Appendix" has been deleted from the specification and the term "Table 6.1-6.15" has been inserted therefor.

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Other Amendments to the Specification

Applicants amended the specification on page 13, line 27 to correct a typographical error by replacing a semicolon (";") with a period ("."). No new matter was added by the amendment to the specification.

Applicants amended the specification to correct a typographical error in the legend for Fig. 2A-2C on page 17, line 30. Specifically, Fig. 2C shows the sequence of a portion of the nucleic acid construct depicted in Fig. 2B. Originally filed Fig. 2C indicates that that sequence is SEQ ID NO:13 and thus provides support for the amendment. Correction of the legend for Fig. 2C has been corrected accordingly. No new matter has been added by the amendment to the specification.

Election/Restriction

The Examiner has indicated that the application contains claims directed to patentably distinct species of the claimed invention and requires restriction under 35 U.S.C. § 121 according to the eight groupings indicated in the Office Action (Paper No. 4, mailed July 5, 2001)

In addition, Applicants were asked to further elect patentably distinct species of the claimed invention as indicated on page 4 of the Office Action. Applicants elect with traverse, for the reasons stated herein, the following species:

The constant domain is from a human IqG.

The anti-Ob-R/anti-HER3 species.

Applicant respectfully traverses the restriction and election requirement as applied to the currently pending claims for the reasons provided below.

Applicant respectfully traverses the restriction requirement in which free thich or protuberance/cavity structures within the multimosimation is main and selicitum of the summent the restriction. The

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class 530 and subclass 387.3 as another multispecific antibody of the invention comprising a protuberance and cavity in the multimerization domain (Group IV). Thus, the Examiner would not be placed under an undue burden to search in the same class and subclass of art in order to evaluate the patentability of claims in Groups III and IV, for example. The same argument applies to Groups I and II, Groups V and VI, and Groups VII and VIII. Applicants respectfully submit that the restrictions that distinguish Group I from Group II, Group III from Group IV, Group V from Group IV, and Group IV from Group VIII should be withdrawn.

Without acquiescing to the restrictions, however, and merely to expedite prosecution of the claims, Applicants elect with traverse Group IV, Claims 12-14, 16-18, 31 and 33 drawn to a multispecific antibody, wherein the multimerization domain is altered to comprise a protuberance and a cavity.

With respect to the election of species requirement, Applicants respectfully traverse the election requirement for failing to recognize Applicant's right to allowed claims that link a reasonable number of species under 37 CFR § 1.141. It is Applicant's understanding and right under 37 CFR § 1.141 that, following election, the claims will be examined fully with respect to the elected species and further to the extent necessary to determine patentability for a reasonable number of species encompassed by the generic claims.

With the above reservation of right, Applicant elects, with traverse, a constant domain from a human IgG and further elects anti-Ob-R/anti-HER3, an illustrative example of the claimed multispecific antibody of the invention.

A marked-up version and a clean version of the pending claims is attached.

If the Examiner has any questions, the Examiner should feel free to $z^{1/2}$ the undersigned attorney at the number indicated below.

This document is timely filed with a petition and fees for a three-month extension of time. In the unlikely event that additional fees are due, Applicants hereby petition the Commissioner to authorize any extensions of time and/or to deduct fees from or add credits to our Deposit Account 07-0630 as necessary to maintain the pendency of this application.

Respectfully submitted,

GENENTECH, INC.

Date: November 5, 2001

Deirdre L. Conley, Ph.D.

Reg. No. 36,487

Telephone No. (650) 225-2066

09157

PATENT TRADEMARK OFFICE

Doc. #99911

VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Deleted information is shown in strikethrough (Θ) , and added information is shown as <u>underlined</u>.

Paragraph beginning at page 13, line 26, has been amended as follows:

(ii) recovering the multispecific antibody from the host cell culture; $\underline{\ }$

Paragraph beginning at page 17, line 16, has been amended as follows:

Figs. 2A-2C. Fig. 2A diagrams a selection scheme for C_03 heterodimer using phage display vector, pRA2. Phage displaying stable C.3 heterodimers are captured using an antibody directed to the gD flag. Fig. 2B diagrams a didistronic operon in which Ca3 expressed from a synthetic gene is co-secreted with a second copy of Cg3 expressed from the natural gene (Ellison et al. Nucleic Acids Res. 10:4071-4079 (1982)) as a fusion protein with M13 gene III protein. The synthetic C₉3 gene is preceded by a sequence encoding a peptide derived from herpes simplex virus glycoprotein D (qD flag, Lasky, L. A. and Dowbenko, D. J. (1984) DNA $\underline{3}$:23-23; Berman, P. W. et al., (1985) Science 227:1490-1492 and a cleavage (G) site for the site-specific protease, Generase ! (Carter, P. et al. (1989) Proteins: Structure, Function and Genetics 6:240-248). Fig. 2C is the nucleic acid sequence of the dicistronic operon (SEQ ID NO:1) (SEQ ID NC: 13) of Fig. 2B in which the residues in the translated 0.3 genes are numbered according to the

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gene (366, 368, and 407).

Paragraph beginning at page 96, line 8, has been amended as follows:

--A large human single chain Fv (scFv) antibody library (Vaughan et al. (1996), supra) was panned for antibodies specific for eleven antigens including Axl(human receptor tyrosine kinase ECD), GCSF-E (human granulocyte colony stimulating factor receptor ECD), IgE (murine IgE), IgE-R (human IgE receptor α chain), MPL (human thrombopoietin receptor tyrosine kinase ECD), Musk (human muscle specific receptor tyrosine kinase ECD), NpoR (human orphan receptor NpoR ECD), Ese (human receptor tyrosine kinase, Ese, ECD), HER3 (human receptor tyrosine kinase HER3/cerbB3 ECD), Ob-R (human leptin receptor ECD), and VEGF (human vascular endothelial growth factor) where ECD refers to the extracellular domain. The nucleotide sequence data for scFv fragments from populations of antibodies raised to each antigen was translated to derive corresponding protein sequences. The V sequences were then compared using the program "align" with the algorithm of Feng and Doolittle (1985, 1987, 1990) to calculate the percentage identity between all pairwise combinations of chains (Feng, D.F. and Doolittle, R.F. (1985) J. Mol. Evol. <u> 21</u>:112-123; Feng, D.F. and Doclittle, R.F. (1987) J. Mel. Evol. 25:351-360; and Feng, D.F. and Doolittle, R.F. (1990) Methods Engymol. 183:375-387). The percent sequence identity results of each pairwise light chain amino acid sequence comparison were arranged in matrix format (Appendix) (Table 6.1-6.15).

The Appropriate is amonded to become Table 6.1-6.15 as follows:

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APPENDIX -1- Toble

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APPENDIX =14- 6.14

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APPENDEX -15- 6.15

In the Claims:

Claims 1-11, 15, 19-30 and 32 have been cancelled. Claims 34-38 have been added.

Claims 12-14, 16, 31, and 33 have been amended as follows:

12. (Amended) A multispecific antibody prepared by the method [of claim 1] comprising:

(a) expressing in a host cell a first polypeptide comprising a first heavy chain variable domain, a first or second light chain variable domain, and a first multimerization domain, wherein the first and second light chain variable domains have at least 80% amino acid sequence identity, and wherein a first binding domain is formed by the first heavy chain variable domain and the first or second light chain variable domain;

(b) expressing in the host cell a second polypeptide comprising a second heavy chain variable domain, the first or the second light chain variable domain, and a second multimerization domain, wherein a second binding domain is formed by the second heavy chain variable domain and the first or second light chain variable domain, and wherein the first and second binding domains bind different antigens;

(c) allowing the first and second polypeptides to dimerize by interaction of the first and second multimerization domains to form a multispecific antibody; and

d) recovering the multispecific antibody from the host cell.

13. (Amended) A multispecific antibody comprising a first polypeptide and at least one additional polypeptide [which meet at an interface, wherein], the multispecific antibody comprising:

[(a) the first polypertide comprises a multimerization domain

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additional polypeptides comprise a common sequence] (a) the first polypeptide which comprises a first heavy chain variable domain, a first or second light chain variable domain, and a first multimerization domain, wherein the first and second light chain variable domains have at least 80% amino acid sequence identity, and wherein a first binding domain is formed by the first heavy chain variable domain and the first or second light chain variable domain; (b) the second polypeptide which comprises a second heavy chain variable domain, the first or the second light chain variable domain, and a second multimerization domain, wherein a second binding domain is formed by the second heavy chain variable domain and the first or second light chain variable domain, and wherein the first and second binding domains bind different antigens; (c) the first and second polypeptides dimerize by interaction of the first and second multimerization domains to form a multispecific antibody. 14. (Amended) The multispecific antibody of claim 13, wherein the nucleic acid encoding the first polypeptide or the nucleic acid encoding the additional polypeptide, or both, has been altered from the original nucleic acid to encode the [interface] multimerization domain or a portion thereof. 16. (Amended) The multispecific antibody of claim 14 wherein the [interface of the] multimerization domains of the first and an additional polypeptide comprise a protuberance and davity, respectively. 31. (Amended) The multispecific antibody of claim 13 [selected from the group consisting of] wherein the antibody is anti-Ob-R/anti-HERRY CARREST AND CAMPBERS ing the product of the countries of the de Rolanti HHERty and antieMeloanti HERts.

- 34. (New) The multispecific antibody of claim 13, wherein the first and second light chain variable domains have at least 90% amino acid sequence identity.
- 35. (New) The multispecific antibody of claim 13, wherein the first and second light chain variable domains have at least 95% amino acid sequence identity.
- 36. (New) The multispecific antibody of claim 13, wherein the first and second light chain variable domains have at least 98% amino acid sequence identity.
- 37. (New) The multispecific antibody of claim 13, wherein the first and second light chain variable domains have at least 99% amino acid sequence identity.
- 38. (New) The multispecific antibody of claim 13, wherein the first and second light chain variable domains have identical amino acid sequences.